Supreme Court, U.S.
FILED
DEC 9 1998
CLERK

No. 98-322

IN THE

Supreme Court of the United States

OCTOBER TERM, 1998

EXXON CORPORATION AND
EXXON CHEMICAL PATENTS, INC.,
Petitioners,

v.

THE DOW CHEMICAL COMPANY,
Respondent.

On Petition for a Writ of Certiorari To The United States Court of Appeals For the Federal Circuit

PETITIONERS' SUPPLEMENTAL BRIEF

E. EDWARD BRUCE
(Counsel of Record)
COVINGTON & BURLING
1201 Pennsylvania Ave., N.W.
Washington, D.C. 20004-7566
(202) 662-6000

Attorney for Petitioners

PETITIONERS' SUPPLEMENTAL BRIEF

Pursuant to this Court's Rule 15.8, petitioners file this supplemental brief to bring to the Court's attention an intervening matter that was not available when petitioners filed their reply brief.

Counsel of record discovered on December 7, 1998, that the appellees in *Hunter Douglas, Inc.* v. *Harmonic Design, Inc.*, 153 F.3d 1318 (Fed. Cir. 1998), had obtained an extension of time until December 10 to file a petition for certiorari to this Court from that decision. Counsel of record has ascertained that appellees in *Hunter Douglas* will, in fact, file such a petition on December 10, albeit via the first-class mail procedure described in this Court's Rule 29.2. In these circumstances, the *Hunter Douglas* petition may not arrive at the Court until as late as December 14 or 15. Because the petition and reply brief in this case discuss at length the Federal Circuit's decision in *Hunter Douglas* — which applied the rule of this case as the law of the circuit in *Hunter Douglas* — and because the Court has withheld action on the petition in this case since the November 13 conference, it seems advisable to apprise the Court of the imminent receipt of the *Hunter Douglas* petition.

The Court may wish to continue holding the petition in this case pending its consideration of the petition in *Hunter Douglas*, thus leaving open the possibility that both petitions could be granted and consolidated for plenary disposition. The Court might elect to choose this approach because this case squarely presents the issue of imposing damages liability upon a patentholder who is alleged to have been guilty of inequitable conduct at the Patent and Trademark Office and thereafter transmitted the infringement notices required by 35 U.S.C. § 287(a). *See* Petn. pp. 8-11. *Hunter Douglas* involved no such statutory infringement notices. However, in that case the Federal Circuit found that the district court had

exclusive subject matter jurisdiction under 28 U.S.C. § 1338 and the Federal Circuit had exclusive appellate jurisdiction under 28 U.S.C. § 1295(a)(1) over claims of inequitable conduct, and it did not address those issues in this case. *See* Petn. 18, n.14; Reply Br. 7-8.

Respectfully submitted,

E. Edward Bruce
(Counsel of Record)
COVINGTON & BURLING
1201 Pennsylvania Ave., NW
Washington, D.C. 20004-7566
(202) 662-6000

Attorney for Petitioners

December 9, 1998